

REMARKS

This is a full and timely response to the outstanding final Office Action mailed May 19, 2006. Reconsideration and allowance of the application and pending claims are respectfully requested.

I. Claim Rejections - 35 U.S.C. § 103(a)**A. Statement of the Rejections**

The Office Action indicates that claims 37-43 and 47-66 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Gudorf et al.* ("*Gudorf*," U.S. Pub. No. 2002/0174230) and further in view of *Bradford* ("*Bradford*," U.S. Pat. No. 5,805,747). The Office Action indicates that claims 44-46 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Gudorf* and *Bradford* and further in view of *Gillespie et al.* ("*Gillespie*," U.S. Pub. No. 2002/0059243). Applicants respectfully traverse these rejections.

B. Discussion of the Rejection

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

In the present case, Applicants respectfully submit that a *prima facie* case for obviousness has not been established.

Independent Claim 37

Claim 37 recites (with emphasis added):

37. A system comprising:

a browser having an applications program interface (API) and a user identification (ID) coupled to the API, the user ID comprising a reference to a user profile associated with a profile store, the user profile comprising a reference to a graphics store and a composition store associated with a user, the API exposed to web content downloaded to the web browser over a network, the web content comprising one or more graphics;

a user profile server comprising the profile store, wherein the profile store comprises user specific data;

a graphics server comprising the graphics store, wherein the graphics store is configured to enable network access by the browser of the one or more graphics; and

a composition server comprising the composition store, wherein the composition store comprises one or more compositions that determine the manner in which the one or more graphics are mapped into a series of web pages,

wherein the browser is coupled over a network to the user profile server, the graphics server, and the composition server, and wherein the API is configured to make the user specific data and the one or more graphics formatted according to the one or more compositions available to a first web service, wherein the API is configured to enable the first web service to perform optical character recognition on the one or more graphics in response to a request by the first web service for information pertaining to the user profile.

Applicants respectfully submit that *Gudorf* in view of *Bradford*, assuming *arguendo* a proper combination, fails to disclose, teach, or suggest at least the emphasized claim features. The Office Action refers to paragraphs 0004, 0026, and 0056-0059 for the claim features, *the user profile comprising a reference to a graphics store and a composition store associated with a user*. However, Applicants respectfully note that none of these sections recite a *user profile* that comprises a *reference to a...composition store associated with a user*. In fact, Applicants respectfully submit that to assert that *Gudorf* discloses or suggests that would be objectively unreasonable in view of the arrangement described in paragraph 0045 and shown in Figure 3. For instance, page 3 of the Office Action appears to equate the *composition store* to the "default portal templates 102" shown in Figure 3 of *Gudorf* and described in paragraph 0045. Paragraph 0045 is reproduced below as follows:

[0045] The user characterization database 96 is accessed by a publisher of a web site, depicted as a portal provider 100, to personalize default portal templates 102 with associated content 104. In particular, the portal provider 100 provide matches associated content 104 with the user characterization database 96 to populate a selected default template 102 with personalized on-line content 106.

Referring to Figure 3 and paragraph 0045 of *Gudorf*, and assuming *arguendo* that the default portal template 102 is the *composition store*, it appears that the portal provider 100 accesses the templates and populates the same with data from the database 96. Given that arrangement, it is unlikely that a *user profile*, assuming *arguendo* one exists, comprises *a reference to...a composition store associated with a user* at least since the templates in the default portal template 102 appear to be generic in nature, dis-associated with any particular user, and not utilized by a web browser or user profile. *Bradford*, representing what appears to be an entirely different technology and architecture, not

surprisingly fails to remedy this deficiency. For at least the reasons presented above, Applicants respectfully request that the rejection to independent claim 37 be withdrawn.

Also, even assuming *arguendo* the proposed combination is proper, *Gudorf* in view of *Bradford* does not disclose, teach, or suggest at least *a browser having an applications program interface (API) and a user identification (ID) coupled to the API*. *Bradford* appears to show an *API*, but not a *browser*. *Gudorf* appears to show a *browser*, but not an *API* and not "OCR" technology. Applicants are reminded of a quotation from *Laitram Corp. v. Cambridge Wire Cloth Co.*, 226 USPQ 289, 293 (D. Md. Mag. 1985) with regard to inventiveness, where the court stated "To illustrate this notion, you cannot claim that the existence of a unicorn should be obvious from taking a trip to the zoo and seeing a horse and a white rhinoceros in adjacent cages. It takes a spark of inventiveness to look at a horse and then look at a white rhinoceros and then conceive the idea of a white horse with a horn." Similarly, it takes, at the very least, a spark of inventiveness to look at a *browser*, an *API*, and a *user ID*, then conceive the idea of a *browser having an API and a user identification (ID) coupled to the API*.

Additionally, Applicants respectfully disagree with the assertion on page 4 of the Office Action that it "would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined *Gudorf*'s system with *Gudorf*'s servers, since it would have allowed for greater processing performance and storage capacity (paragraph 0024)." Even assuming that greater processing performance and storage capacity would result, that assertion alone simply not a sufficient basis to assert obviousness since there is no teaching or suggestion in the references to use separate servers for the *graphics store* and *composition store*.

Further, Applicants respectfully submit that the proposed combination of *Gudorf* in view of *Bradford* is not obvious. For instance, one indicia of unobviousness recognized by the Federal Circuit and the USPTO pertains to the absence of a motivation to combine references. Page 4 of the Office Action offers the following reasoning for the combination:

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined *Gudorf* with *Bradford*, since it would have allowed a plurality of devices to interact without user interference (*Bradford*: column 7, lines 49-67).

Applicants respectfully disagree, and believe that, at least in view of the disparate systems and problems to be solved in *Gudorf* and *Bradford*, such a proposed combination is more likely the result of improper hindsight reasoning. Federal case law makes it clear that an obviousness analysis requires an "as a whole" assessment, which Applicants respectfully submit has not been performed in the instant case. In particular, *Princeton Biochemicals Inc. v. Beckman Coulter Inc.*, 75 U.S.P.Q.2d. 1051, 1054 (Fed. Cir. 2005) makes it clear that "[T]itle 35, section 103, requires assessment of the invention as a whole. This "as a whole" assessment of the invention requires a showing that an artisan of ordinary skill in the art at the time of the invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention, would have selected the various elements from the prior art and combined them in the claimed manner." Applying to the present case, one exemplary problem addressed by Applicants' system and method pertains to the tediousness of entering user specific data through a browser for various web services. *Gudorf* emphasizes the provision of hypertext on-line content to an Internet browser. (see paragraph 0001) A keyword search of *Bradford* fails to reveal any mention of a

"browser" or the "Internet," and in fact, has nothing to do with the handling of user-specific or personalized data. According to the Abstract of *Bradford*, *Bradford* is concerned with "an optical character recognition (OCR) system an[sic] improved method and apparatus for recognizing the character and producing an indication of the confidence with which the character has been recognized." Likewise, there is no mention of optical character recognition in *Gudorf*. Clearly *Gudorf* and *Bradford* address distinct problems using distinct solutions. As Federal case law makes clear, "[F]urthermore, the teaching, motivation, or suggestion must be present within the cited references. *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed.Cir.1988). Applicants respectfully submit that an "as a whole" assessment has not been employed in the final Office Action and further that a *prima facie* case for obviousness has not been established. Accordingly, Applicants respectfully request that the rejection be withdrawn.

Because independent claim 37 is allowable over *Gudorf* in view of *Bradford*, and *Gillespie* does not remedy the above described deficiencies, dependent claims 38-42, 44, and 46-54 are allowable as a matter of law for at least the reason that the dependent claims 38-42, 44, and 46-54 contain all elements of their respective base claim. See, e.g., *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Independent Claim 56

Claim 56 recites (with emphasis added):

56. A method for providing user-specific web pages, comprising:
receiving web content comprising one or more graphics;
responsive to activation by the web content:
storing the one or more graphics in a network accessible graphics
store;

creating one or more compositions corresponding to the manner in which the one or more graphics are mapped into web pages and storing the same in a network accessible composition store;

in response to a web service request for information, enabling access of a user profile by the web service, the user profile associated with a network accessible profile store, *the user profile comprising a reference to the graphics store, the composition store, and the one or more compositions; and*

enabling optical character recognition by the web service of the one or more graphics to provide the requested information for use in presentation in the web pages with data specific to a user corresponding to the user profile and with the one or more graphics formatted based on the one or more compositions.

For similar reasons presented above in association with claim 37, and in particular, the discussion pertaining to the absence in the art of record of the *user profile comprising a reference to the...composition store* and the unobviousness of the proposed combination, Applicants respectfully submit that *Gudorf* in view of *Bradford*, assuming proper combination, fails to disclose, teach, or suggest at least the emphasized claim features and further that the proposed combination is not obvious. Accordingly, Applicants respectfully submit that independent claim 56 is allowable over the art of record.

Because independent claim 56 is allowable over *Gudorf* in view of *Bradford*, dependent claims 57 and 59-65 are allowable as a matter of law.

Independent Claim 66

Claim 66 recites (with emphasis added):

66. A system comprising:
means for receiving web content comprising one or more graphics;
responsive to activation by the web content:
means for storing the one or more graphics in a network accessible graphics store and creating one or more compositions corresponding to the manner in which the one or more graphics are mapped into web pages and storing the same in a network accessible composition store;

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in response to a web service request for information, means for enabling access of a user profile by the web service, the user profile associated with a network accessible profile store, *the user profile comprising a reference to the graphics store, the composition store, and the one or more compositions*; and

means for enabling optical character recognition by the web service of the one or more graphics to provide the requested information for use in presentation in the web pages with data specific to a user corresponding to the user profile and with the one or more graphics formatted based on the one or more compositions.

For similar reasons presented above in association with claim 37, and in particular, the discussion pertaining to the absence in the art of record of the *user profile comprising a reference to the...composition store* and the unobviousness of the proposed combination, Applicants respectfully submit that *Gudorf* in view of *Bradford* fails to disclose, teach, or suggest at least the emphasized claim features and further that the proposed combination is not obvious. Accordingly, Applicants respectfully submit that independent claim 66 is allowable over the art of record.

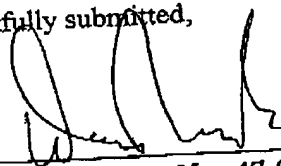
In summary, it is Applicants' position that a *prima facie* for obviousness has not been made against Applicants' claims. Therefore, it is respectfully submitted that each of these claims is patentable over the art of record and that the rejection of these claims should be withdrawn.

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Serial No.: 09/993,116
Art Unit: 2178**CONCLUSION**

Applicants respectfully submit that Applicants' pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



David Rodack, Reg. No. 47,034

THOMAS, KAYDEN,
HORSTEMEYER & RISLEY, L.L.P.
Suite 1750
100 Galleria Parkway N.W.
Atlanta, Georgia 30339
(770) 933-9500

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